

**REMARKS**

With the entry of the foregoing amendments, claim 1 is pending in this application, and has been presented in better form for appeal. A Notice of Appeal is being filed concurrently with this Amendment.

Claim 1 has been amended to incorporate the subject matter from claim 13, and claim 13 has been cancelled without prejudice. Claims 2-12 have been cancelled without prejudice with the right to re-present them upon allowance of amended claim 1 that is being appealed. As stated in the Advisory Action of February 3, 2010, claim 1 as amended in the foregoing fashion does not present any new issue, i.e., the Advisory Action simply notes that the claims depending from amended claim 1 allegedly present new issues – with which applicant disagrees. In other words, if claim 1 is allowable, then the claims depending from claim 1 are allowable.

The incorporation of the claim 13 subject matter into claim 1 renders moot all of the rejections with the sole exception of the rejection of claim 13, i.e., where claims 1, 3, 7, 8, and 13 stand rejected as allegedly being anticipated by Subba Rao (USP 6743235). Applicant respectfully traverses this rejection for at least the following reasons.

The claimed invention requires an orientation means of the dual-axis type. See amended claim 1. Rao is limited to and expressly teaches the use of a single-axis type, as those of skill in the art readily know and understand. Thus, Rao does not anticipate the claimed invention. Rao actually teaches away from the claimed invention. Indeed, Rao has no desire or contemplation to use a dual-axis type orientation as claimed and understood to those of skill in the art.

As one skilled in the art can see in the Rao figures, the Rao orientation means comprise a bubble level that is designed for orienting the device along a single direction. With this Rao device, even when the bubble is located at the right place (i.e., between the two marking lines), there is an infinite number of possibilities to move, e.g., rotate, the device in other positions while maintaining the bubble at the right place. This is not the case with the claimed device that requires a dual-axis type orientation means. One such embodiment of the claimed invention is illustrated in Figure 1A. The device includes two bubble levels (reference numbers 9 and 10). Using a dual-axis type orientation means, e.g., a two bubble levels instead of a one bubble level, allows a surgeon to position the claimed device in one unambiguous single position. Rao does not disclose, contemplate, or even remotely suggest this critical feature and its objective.

In summary, the claimed device is positioned thanks to the dual-axis type orientation means while in the Rao reference the orientation means are not sufficient to position the device as contemplated by the claimed invention. Instead, an additional input from the surgeon is required by the Rao device.

In this regard, applicant notes that the claimed guide for an acetabular prosthetic cup instrument comprises an **orientation means, distinct from the shaft, which are adapted to define a reference plane, and the orientation means are of the dual-axis type**. All of these features are significant and clearly distinguish over Rao and any other prior art. The claimed features define a reference plane. The applicant's device requires at least two axes (or one axis and one point) in order to define a reference

plane. In contrast, if there is only one axis, then no reference plane can be defined but, instead, an infinite number exist and no reference plane is defined.

Moreover, Rao does not appreciate or even attempt to define a reference plane and, therefore, would not be combined with any other reference in any "reasonably apparent" fashion (as required by the Supreme Court) to arrive at the claimed invention -- without running counter to the single axis teachings of Rao and without improperly using hindsight reasoning.

For at least the foregoing reasons, applicant respectfully requests the withdrawal of the prior art rejections and passage of the application to allowance.

If the Examiner has any questions concerning this application, the undersigned may be contacted at 703-816-4009. If any small matters remain in this case, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: /Duane M. Byers/

Duane M. Byers  
Reg. No. 33,363

DMB:lmo  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100